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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,236	03/01/2000	William A. Aiello	1999-0053	3274

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EXAMINER

ADAMS, JONATHAN R

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/516,236

Applicant(s)

AIELLO ET AL.

Examiner

Jonathan R Adams

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 18, 20, 22 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18, 20, 22 and 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The final office action mailed on July 21, 2004 has been VACATED. See the attached interview summary. The after final amendment filed on September 22, 2004 has not been entered.
2. Claims 1-15, 18-20, 22, and 34-39 are pending.

Specification

3. The disclosure is objected to because of the following informalities: On Page 12 of the specification BTI is referenced as element 140 and so is the provisional server 140. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7, 18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons given in the vacated final office action.

Claim Rejections - 35 USC § 102

Art Unit: 2134

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Patent No.

5,153,919, Reeds, III et al for the reasons given in the vacated final office action.

8. Claims 8-15, 18-20, 22, 34, 38 rejected under 35 U.S.C. 102(e) as being anticipated by Patent No. 6094485, Weinstein et al. for the reasons given in the vacated final office action.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2134

10. Claims 2-7, 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. 6094485, Weinstein et al. in view of Patent No 6675216, Quatrano et al. for the reasons given in the vacated final office action.

11. Claims 36-37 rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. 6094485, Weinstein et al. in view of Patent No 6675216, Quatrano et al. in further view of Patent No. 6681327, Jardin for the reasons given in the vacated final office action.

12. Claim 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. 6094485, Weinstein et al. in view of Patent No. 6681327, Jardin for the reasons given in the vacated final office action.

Response to Arguments

13. Applicant's arguments filed on page 8, dated 4-30-2004 has been fully considered but they are not persuasive.

14. Regarding claim 1, applicant contests that a provisioning server that there is not teaching for authenticating the base station. This examiner respectfully disagrees. See the newly formed rejection above. It can be said that the a mutual authentication takes place between the mobile unit and the base station (Reeds 111, col. 8, line 50-68), where both units authenticate each other by challenge/response steps. Furthermore, applicant contests on page 9 that a cryptographic key is cannot be asserted from the authentication string sited in Reed 111. The independent merely states "cryptographic

key associated with the user" which authentication string (Reeds 111, col. 5, line 60-61, col. 6, line 7-10) shows. The authentication string is hashed/encrypted to produce SSD (shared secret data, Reeds III, Col. 6, line 1 1-12) which is used to encryption of some signaling message (SSD-B, Reeds 111, col. 6, line 14- 18). Thusly the rejections stand.

15. Applicant's arguments with respect to claim 12-20, 22 have been considered but are moot in view of the new grounds of rejection.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan R Adams whose telephone number is

Art Unit: 2134

(571)272-3832. The examiner can normally be reached on Monday – Friday from 10am to 6pm.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is (571)272-3838. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read "Andrew Caldwell", with a stylized flourish at the end.

**ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER**